

Response to Restriction Requirement  
U.S. Serial No. 10/719,622  
Filed: November 21, 2003  
Attorney Docket No: 847-072

## **REMARKS**

Claims 1-5 were presented.

Claims 1-2 (Group I), drawn to a motor apparatus, were deemed to correspond to class 310, subclass 87.

Claims 3-5 (Group II), drawn to a method of washing a motor, were deemed to correspond to class 029, subclass 596.

The Restriction Requirement states that the inventions are distinct because, “[i]n the instant case, the apparatus can be made by a materially different process, such as cleaning the motor components prior to assembly because motor claims do not require the washing of the motor only the ability to wash the motor by admitting and removing a washing fluid.”

Applicant has canceled claims 3-5 without prejudice and has added new claims 6-13 that depend, directly or indirectly from claim 1.

New claims 6-10 are directed to the motor apparatus and include additional features described in the specification and in the drawings as originally filed. New claims 6-10 more particularly point out the subject matter that is claimed. Support for new claims 6-10 is found throughout the Specification and Drawings and at least at the paragraphs identified in the following table. Applicant respectfully submits that no new matter is introduced by the Amendment.

Claim	Support at paragraph(s) number as in original filing
6	[00029], [00038]
7	[00032], [00033], [00036], [00037]
8	[00038], [00041]
9	[00031], [00040]
10	[00031], [00040]

New claims 11-13 parallel most of the elements of original claims 3-5, but include in claim 11 the step of “providing an unsealed washable electric motor assembly according to claim 1.” By operation of 35 U.S.C. §112, 4<sup>th</sup> paragraph, this limitation is also present in new claims

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12 and 13 which depend from claim 11. Claims 11-13 cannot be infringed without there being present an unsealed washable electric motor assembly such as is claimed in claim 1. Support for claims 11-13 is found in claim 1 and in originally filed claims 3-5. No new matter is added by this amendment.

Applicant elects amended Group I which includes claims 1, 2, and new claims 6-10 drawn to a motor apparatus, as well as new claims 11-13 drawn to washing the motor apparatus of claim 1.

The original claims 1, 2 and new claims 6-13 are presented as a bona fide effort to advance the application to allowance. After entry of the amendments, Claims 1, 2 and 6-13 are pending in the application.

#### **Argument for Adding Claims 6-10 to Group I**

Applicant has elected Group I.

New claims 6-10 add as dependent claims further features of the motor of claim 1 that are disclosed and supported by the Specification and the Drawings as filed. There should be no issue as to the amendment of new claims 6-10 into the application, nor should there be any issue that they too are plainly drawn to the same class of invention as claim 1, and plainly should be allowed entry into Group I.

#### **Argument Why Claim 1 And Claims 11-13**

##### **Do Not Represent Distinct Inventions Under 35 U.S.C. §121**

New claims 11-13 depend from claim 1, directly or indirectly. 35 U.S.C. §112, 4<sup>th</sup> paragraph recites in relevant part “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” Claim 11 as presently drawn requires the presence of “an unsealed washable electric motor assembly according to claim 1.” None of claims 11-13 can be infringed without an apparatus according to claim 1 being present. Therefore, the argument that the process of any of claims 11-13 can be performed with another and materially different product (which would have to be production of a motor assembly of some other kind) is contradicted on its face by the limitation of claim 11 that one must have present a device that claim 1 would read upon. Equally, the argument that the

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product as claimed (here the cleaned unsealed washable electric motor assembly according to claim 1) can be made by another and materially different process is unsustainable, because only if the unsealed washable electric motor assembly according to claim 1 is present does any of claims 11-13 have any applicability. Cleaning a different motor by this process is not claimed. Neither does the Applicant claim the process of cleaning the device of claim 1 by any process not disclosed in the Specification.

Applicant respectfully submits that new claims 11-13 do not satisfy either of the requirements that are necessary to permit the conclusion that the inventions of claim 1 and claims 11-13 are distinct as argued in the present Restriction Requirement under 35 U.S.C. §121.

**Based on the arguments presented above, Applicant respectfully submits that claims 1, 2, and new claims 6-10 and new claims 11-13 do not represent distinct inventions under 35 U.S.C. §121 because the required showings recited in MPEP 806.05(f) are not present in the claims as presently presented.**

#### **Compulsory Election**

The Restriction Requirement also states that “Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).” Accordingly, Applicant under the compulsion expressed in 37 CFR 1.143 elects Group I if the argument presented herein to traverse the Restriction Requirement is not sustained.

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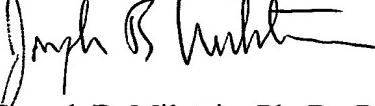
### CONCLUSION

Applicant has cancelled claims 3-5 of Group II. Applicant has added new claims 6-10 to more particularly claim the apparatus of claim 1. Applicant has added new claims 11-13 that depend from claim 1. Applicant has presented reasons why all of claims 1, 2, 6-10, and 11-13 do not represent distinct inventions under 35 U.S.C. §121. Applicant submits that claims 1, 2, 6-10, and 11-13 are now in proper condition for allowance, and requests the issuance of a Notice of Allowance at the Examiner's earliest convenience. In the event that the Restriction Requirement is not withdrawn, Applicant elects to prosecute the claims in Group I, including at least claims 1, 2, and 6-10.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is requested to call Applicant's attorney at the phone number noted below.

Respectfully submitted,  
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